



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,577	10/02/2006	Gerit Erbeck	033171-134	1989

25570 7590 03/31/2009
ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN, VA 22102-8064

EXAMINER

PEDDER, DENNIS H

ART UNIT	PAPER NUMBER
----------	--------------

3612

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

03/31/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lgallaugh@rmsclaw.com
dbeltran@rmsclaw.com
bdiaz@rmsclaw.com

Office Action Summary	Application No. 10/599,577	Applicant(s) ERBECK ET AL.	
	Examiner Dennis H. Pedder	Art Unit 3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 02 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 21, 3-4, 8-20, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bienert et al. in view of applicant's admitted prior art, and optionally either Bolton et al. reference.
4. Bienert et al. have cement/shatterproof element 6, cemented to the pane. As applicant points out, the Bienert et al. reference lacks detail as to whether the element 6 is adhesive on the lower side to thereby cement the frame member 7 to the pane 5. The part 7 is, however, both a reinforcing and retaining element and the element 6 is sandwiched between 7 and the pane.

Art Unit: 3612

5. Applicant admits on page 5 that “the material of the cement layer (14) acting as a shatterproofing element is preferably ethylene/methacrylic acid copolymers. This material is sold under the trademark "SENTRYGLASS PLUS" from DuPont, Wilmington, USA. It is an ionomer material. In view of this admission, it is understood that applicant is preferably using a commercially available material for its known adhesive properties to replace a previously known material with lesser properties, i.e. lacking a lower surface of adhesive, and therefore such a substitution is not a patentable distinction, but rather merely common sense to further bond the element 7 of Bienert et al. to the pane, thereby increasing securement. For example, Bienert relies on the sealing material 17 for final disposition of the assembly. Use of an adhesive coated bottom of member 6, as may be disclosed by applicant (see above) would allow securement of the lower frame member while the sealing material evaporates and sets. It would have been obvious to one of ordinary skill to provide in Bienert et al. the commercially available material with 2) adhesive top and bottom portion as admitted by applicant and apparently confirmed by applicant on page 6 of the remarks of 10/17/2008 in order to improve assembly of the device of Bienert et al. at an intermediate stage of assembly.

6. With regard to applicant’s argument that the “commercially available cementitious shatterproofing material were known to have the requisite properties to securely attach such vehicle parts”, no such properties are claimed, the claims merely setting forth that the material “directly secures at least one metal attachment part to the pane”. In this regard, applicant is advised that the properties of the commercially available material in regard to metal adhesion are known in the art as of at least 8/31/2005 (see two cited web entries). While this is prior to applicant's priority date of 3/31/2004, it is not conceivable that the engineers and scientists at

Art Unit: 3612

DuPont where not aware of this inherent property of their material. Further “the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ430, 433 (CCPA 1977). >In In re Crish, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004), the court held that the claimed promoter sequence obtained by sequencing a prior art plasmid that was not previously sequenced was anticipated by the prior art plasmid which necessarily possessed the same DNA sequence as the claimed oligonucleotides. The court stated that “just as the discovery of properties of a known material does not make it novel, the identification and characterization of a prior art material also does not make it novel.” Id.< See also MPEP § 2112.01 with regard to inherency and product-by-process claims and MPEP § 2141.02 with regard to inherency and rejections under 35 U.S.C. 103.

7. Further, Bolton et al. teach that a glass pane may be cemented to a single side ionomer resin, such as that used by applicant, as well as a protective cover film during an autoclave process, deemed to melt and hence “cement” the three layers together. Given the “cement material”, it would have been obvious to one of ordinary skill to provide in Bienert et al. as modified by a non-adhesive ionomer layer, cementing of components by autoclave as taught by either Bolton et al. reference in order to attach same in a secure manner as discussed by Bolton et al.

8. Claims 3-4, 9-11 and 13 are self-evident from the Bienert et al. reference.

Art Unit: 3612

9. An edge seal, claim 12, use of an attachment part for connection to a positioning mechanism, claim 14, adhering a roof panel edge to a roof frame, claim 15, frit to cover edge connections, claim 16, are all deemed to be of common knowledge in this art, and obvious to use here for their intended purposes. The strength of an adhesive and its elasticity are deemed to be an obvious expedient to one of ordinary skill in the art.

As applicant has not challenged this statement of judicial notice, it is made final.

10. As to claims 18, 22, while the value of tear strength is not given in MJ/m³, a commercially available material, as applicant is using, is deemed to have the properties listed.

11. As to claims 19-20, 23-24, the values now provided regarding the applicant's admitted prior art are above those claimed.

12. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bienert et al. in view of applicant's admitted prior art and either Bolton et al. reference.

13. Bolton et al., prior to the invention of applicant, also teach the use of an ionomer adhesive layer, obtained thru an autoclave process, laminated to a glass to form a safety glass as does that of applicant's admitted prior art.

14. It would have been obvious to one of ordinary skill to provide in Bienert et al. an ionomer adhesive layer as taught by Bolton et al., with a cover film, (see figure 2 of Bolton et al.) in order to form the safety glass with a known material for that purpose and to enclose the lower autoclaved ionomer. Not applying the cover film to the adhesive joint of member 7 and 6 is merely common sense as to do so would destroy any adhesive connection.

15. As to claim 6, scratchproof and tinted films are of common knowledge in the art with self-evident benefits and thus not patentable distinctions.

As applicant has not challenged this statement of judicial notice, it is made final.
16.

17. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bienert et al. in view of applicant's admitted prior art and either Bolton et al. reference as applied to claim 6 above, and further in view of either Choussade et al. or Gourio.

18. It would have been obvious to one of ordinary skill to provide in the references above a cover film of PET, as taught by Choussade et al. or PC, as taught by Gourio in order to provide protection for the laminate.

Response to Arguments

19. Applicant's arguments filed 1/28/2009 have been fully considered but they are not persuasive.

20. Applicant's remarks concerning the cement material are noted and the specification description accepted.

21. Applicant's argument regarding attachment of the reinforcing element to the pane without the need for other elements is noted. However the claims of this application are open ended as to the presence of other attaching elements such as the upper frame member 8 of Bienert et al.

22. Arguments as to the strength of the cement material in this environment are noted. However in view of the inherent metal/glass characteristics as discussed above and the fact that this commercially available material is used for bullet proof and hurricane resistant glass, strength of adhesion does not appear to disqualify the material from conventional automotive applications.

Art Unit: 3612

23. The prosecution of this application appears to have stalled. Applicant may wish to appeal for further opinion of the Board of Appeals.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis H. Pedder whose telephone number is (571) 272-6667. The examiner can normally be reached on 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on (571) 272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3612

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis H. Pedder/
Primary Examiner, Art Unit 3612

Dennis H. Pedder
Primary Examiner
Art Unit 3612

DHP
3/17/2009